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10/706,911	11/14/2003	Jack Robert Arron Clark	03.040.01	7656

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Zilka-Kotab, PC  
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San Jose, CA 95172-1120

EXAMINER

MURDOUGH, JOSHUA A

ART UNIT	PAPER NUMBER
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3609

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09/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/706,911

Applicant(s)

CLARK, JACK ROBERT ARRON

Examiner

Joshua Murdough

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 11, 21, & 31 disclose a licence ticket with a licence key, but do not give sufficient detail to the ticket's nature.

The Examiner, when evaluating the on the merits, has used the broadest reasonable interpretation in regards to a ticket used to acquire software, which allows it to be either physical or electronic.

Claims 8, 9, 18, 19, 28, 29, 38, & 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is not disclosed sufficiently to enable one of ordinary skill in the art to know how "said license key is hidden behind a scratch off covering upon said license ticket," as recited by claims 9, 19, 29, & 39, without undue experimentation for the case where the ticket is electronic.

Furthermore, the only example given in the disclosure regarding the limitation "said license key is hidden upon said license ticket so as to be non-reversibly revealable by said user"

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in claims 8, 18, 28, & 38, is that it could be "behind a scratch-off panel" (Page 5, line 15). This causes the same issue with an electronic ticket.

Given that physically scratching an electronic ticket is not possible, the spirit of the invention was considered. Therefore, the Examiner has evaluated the claims based on the functional equivalent, which requires the revealing or assigning of the key in a manner that forces it to remain static afterwards.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 31-40 are directed to non-statutory subject matter. These claims are to software, which is, per se, non-statutory. Software itself is not tangible, but a medium containing the software is tangible and therefore is statutory. The appropriate inclusion of a computer readable medium in these claims should allow this rejection to be withdrawn.

Claims 8, 9, 18, 19, 28, 29, 38, & 39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. There is no system or method shown for scratching off a panel on an electronic ticket. Since the process is not shown, it is not clear if it belongs to a statutory class.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

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patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis  
(2003/0221112).

As to claim 1, Ellis shows:

A method distributing a computer program product (Paragraph 0022), said method

comprising the steps of:

obtaining a license ticket bearing a license key; (Paragraph 0005)

inputting at a user computer a download source computer address of a download

source computer of a supplier of said computer program product; (Paragraph  
0008)

establishing a computer network connection between said user computer and said

download source computer; (Paragraph 0008)

inputting said license key at said user computer; (Paragraph 0042)

transmitting said license key from said user computer to said download source

computer via said computer network connection; (Paragraph 0008)

validating said license key sent to said download source computer; (Paragraph 0008)

and

if said license key is valid, then:

(i) downloading said computer program product to said user computer; and

(Paragraph 0008)

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(ii) installing said computer program product to be resident upon said user computer  
(Paragraph 0023).

As to claim 2, Ellis further shows:

said license ticket is obtained via a purchase by a user. (Paragraph 0025)

As to claim 3, Ellis further shows:

when said license ticket is purchased a seller of said license ticket transmits data  
indicating sale of said license ticket to said supplier of said computer program  
product. (Paragraphs 0022 & 0028)

As to claim 4, Ellis further shows:

receipt of said data indicating sale of said license ticket validates said license key  
associated with said license ticket such upon subsequent receipt of said license  
key at said download source computer said license key will be treated as valid.  
(Paragraph 0009)

The credit card or smart card information is used to indicate the sale and validate the key.

As to claim 5, Ellis further shows:

said data indicating sale of said license ticket indicates one or more computer  
program products of which download and installation is to be allowed by said  
license key of said license ticket. (Paragraph 0021)

Each content server would have at least one computer program product, and therefore, with  
access to at least one server, one or more computer program products would be indicated by the  
servers that can be accessed.

As to claim 6, Ellis further shows:

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receipt of said data indicating sale of said license ticket triggers said supplier of said computer program product to charge said seller for a license to use said computer program product. (Paragraph 0028)

The API allows access to billing information for the customer when the ticket is used. This information is then used to charge the customer.

As to claim 7, Ellis further shows:

if said license key is valid, then a user account is created associated with said license key. (Paragraph 0009)

As to claims 8 & 9, Ellis further shows multiple encryption and decryption methods to be used to encode the key when placed onto the ticket and later decode the key when the customer needs it (Paragraphs 0092-0100). Typically the encoding algorithm used is not given out, therefore the customer would have no way of encrypting it again.

As to claim 10, Ellis also shows:

said license ticket bears a license ticket identifier used to identify license tickets released to be available to be obtained by a user. (Paragraph 0096)

A HMAC would be unique to the ticket and is used to identify the user, or in this case, the ticket it came from.

As to claim 11, Ellis shows:

A method installing a computer program product, said method comprising the steps of:

obtaining a license ticket bearing a license key; (Paragraph 0005)

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inputting at a user computer a download source computer address of a download source computer of a supplier of said computer program product; (Paragraph 0008)

establishing a computer network connection between said user computer and said download source computer; (Paragraph 0008)

inputting said license key at said user computer; (Paragraph 0042)

transmitting said license key from said user computer to said download source computer via said computer network connection; (Paragraph 0008) and

if said license key is valid, then:

(i) downloading said computer program product to said user computer; (Paragraph 0008) and

(ii) installing said computer program product to be resident upon said user computer. (Paragraph 0023).

As to claim 12, Ellis further shows:

said license ticket is obtained via a purchase by a user. (Paragraph 0025)

As to claim 13, Ellis further shows:

when said license ticket is purchased a seller of said license ticket transmits data indicating sale of said license ticket to said supplier of said computer program product. (Paragraphs 0022 & 0028)

As to claim 14, Ellis further shows:

receipt of said data indicating sale of said license ticket validates said license key associated with said license ticket such upon subsequent receipt of said license



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key at said download source computer said license key will be treated as valid.

(Paragraph 0009)

The credit card or smart card information is used to indicate the sale and validate the key.

As to claim 15, Ellis further shows:

said data indicating sale of said license ticket indicates one or more computer  
program products of which download and installation is to be allowed by said  
license key of said license ticket. (Paragraph 0021)

Each content server would have at least one computer program product, and therefore, with  
access to at least one server, one or more computer program products would be indicated by the  
servers that can be accessed.

As to claim 16, Ellis further shows:

receipt of said data indicating sale of said license ticket triggers said supplier of said  
computer program product to charge said seller for a license to use said computer  
program product. (Paragraph 0028)

The API allows access to billing information for the customer when the ticket is used. This  
information is then used to charge the customer.

As to claim 17, Ellis further shows:

if said license key is valid, then a user account is created associated with said license  
key. (Paragraph 0009)

As to claims 18 & 19, Ellis further shows multiple encryption and decryption methods to  
be used to encode the key when placed onto the ticket and later decode the key when the  
customer needs it (Paragraphs 0092-0100). Typically the encoding algorithm used is not given

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out, therefore the customer would have no way of encrypting it again.

As to claim 20, Ellis also shows:

said license ticket bears a license ticket identifier used to identify license tickets

released to be available to be obtained by a user. (Paragraph 0096)

A HMAC would be unique to the ticket and is used to identify the user, or in this case, the ticket it came from.

As to claim 21, Ellis shows:

A method supplying a computer program product, said method comprising the steps of:

in response to a connection request from a user computer, establishing a computer network connection between said user computer and a download source computer; (Paragraph 0008)

receiving a license key input by a user at said user computer, (Paragraph 0008)

said license key being borne by a license ticket obtained by a user; (Paragraph 0005)

validating said license key sent to said download source computer; (Paragraph 0008)

and

if said license key is valid,

then downloading said computer program product to said user computer (Paragraph 0008)

for installation to be resident upon said user computer. (Paragraph 00023)

As to claim 22, Ellis further shows:

said license ticket is obtained via a purchase by a user. (Paragraph 0025)

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As to claim 23, Ellis further shows:

when said license ticket is purchased a seller of said license ticket transmits data indicating sale of said license ticket to said supplier of said computer program product. (Paragraphs 0022 & 0028)

As to claim 24, Ellis further shows:

receipt of said data indicating sale of said license ticket validates said license key associated with said license ticket such upon subsequent receipt of said license key at said download source computer said license key will be treated as valid. (Paragraph 0009)

The credit card or smart card information is used to indicate the sale and validate the key.

As to claim 25, Ellis further shows:

said data indicating sale of said license ticket indicates one or more computer program products of which download and installation is to be allowed by said license key of said license ticket. (Paragraph 0021)

Each content server would have at least one computer program product, and therefore, with access to at least one server, one or more computer program products would be indicated by the servers that can be accessed.

As to claim 26, Ellis further shows:

receipt of said data indicating sale of said license ticket triggers said supplier of said computer program product to charge said seller for a license to use said computer program product. (Paragraph 0028)

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The API allows access to billing information for the customer when the ticket is used. This information is then used to charge the customer.

As to claim 27, Ellis further shows:

if said license key is valid, then a user account is created associated with said license key. (Paragraph 0009)

As to claims 28 & 29, Ellis further shows multiple encryption and decryption methods to be used to encode the key when placed onto the ticket and later decode the key when the customer needs it (Paragraphs 0092-0100). Typically the encoding algorithm used is not given out, therefore the customer would have no way of encrypting it again.

As to claim 30, Ellis also shows:

said license ticket bears a license ticket identifier used to identify license tickets released to be available to be obtained by a user. (Paragraph 0096)

A HMAC would be unique to the ticket and is used to identify the user, or in this case, the ticket it came from.

As to claim 31, Ellis shows:

A software supply controlling computer program operable to control a download source computer to supply a computer program product to a user computer, said software supply controlling computer program comprising:

connection establishing code operable in response to a connection request from a user computer to establish a computer network connection between said user computer and said download source computer; (Paragraph 0008)

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license key receiving code operable to receive a license key input by a user at said

user computer, (Paragraph 0008)

said license key being borne by a license ticket obtained by a user; (Paragraph 0005)

license key validating code operable to validate said license key sent to said

download source computer; (Paragraph 0008) and

downloading code operable if said license key is valid to download said computer

program product to said user computer (Paragraph 0008)

for installation to be resident upon said user computer. (Paragraph 0023)

As to claim 32, Ellis further shows:

said license ticket is obtained via a purchase by a user. (Paragraph 0025)

As to claim 33, Ellis further shows:

when said license ticket is purchased a seller of said license ticket transmits data

indicating sale of said license ticket to said supplier of said computer program

product. (Paragraphs 0022 & 0028)

As to claim 34, Ellis further shows:

receipt of said data indicating sale of said license ticket validates said license key

associated with said license ticket such upon subsequent receipt of said license

key at said download source computer said license key will be treated as valid.

(Paragraph 0009)

The credit card or smart card information is used to indicate the sale and validate the key.

As to claim 35, Ellis further shows:

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said data indicating sale of said license ticket indicates one or more computer program products of which download and installation is to be allowed by said license key of said license ticket. (Paragraph 0021)

Each content server would have at least one computer program product, and therefore, with access to at least one server, one or more computer program products would be indicated by the servers that can be accessed.

As to claim 36, Ellis further shows:

receipt of said data indicating sale of said license ticket triggers said supplier of said computer program product to charge said seller for a license to use said computer program product. (Paragraph 0028)

The API allows access to billing information for the customer when the ticket is used. This information is then used to charge the customer.

As to claim 37, Ellis further shows:

if said license key is valid, then a user account is created associated with said license key. (Paragraph 0009)

As to claims 38 & 39, Ellis further shows multiple encryption and decryption methods to be used to encode the key when placed onto the ticket and later decode the key when the customer needs it (Paragraphs 0092-0100). Typically the encoding algorithm used is not given out, therefore the customer would have no way of encrypting it again.

As to claim 40, Ellis also shows:

said license ticket bears a license ticket identifier used to identify license tickets released to be available to be obtained by a user. (Paragraph 0096)

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A HMAC would be unique to the ticket and is used to identify the user, or in this case, the ticket it came from.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lopatic (2002/0138441) shows a substantially similar system where the ticket or licence is downloaded with the program and is needed for use.

Sosa (2002/0095387) shows a content purchasing system involving a merchant and creator.

Shibusawa (2002/0092014) shows a software installation system directed toward operating system software.

Stolfo (2001/0044785) shows encrypting personal data from a transaction for privacy reasons.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Murdough whose telephone number is (571) 270-3270.


The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Khoi Tran can be reached on (571) 272-6919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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